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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,665	02/27/2004	Matthew J. N. C. Roche	FORT-002-002	7553
7590	10/03/2006			
Wilfred Lam Innovation Management Sciences P.O. Box 1169 Los Altos, CA 94023-1169			EXAMINER PHAM, HUNG Q	
			ART UNIT 2168	PAPER NUMBER

DATE MAILED: 10/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/789,665	ROCHE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	HUNG Q. PHAM	2168	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Objections*

Claim 27 is objected to because of the following informalities: *communited* (*communicated* is respectfully suggested). Appropriate correction is required.

### *Specification*

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: *a conduit* as in claim 27.

### *Duplicate Claims, Warning*

Applicant is advised that should claim 8 be found allowable, claim 14 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 8-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

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Claims 8-19 direct to a system. instead of defining system by identifying the physical structure of the system in terms of its hardware or hardware and software combination as set forth in MPEP 2106 (IV)(B)(2)(a)<sup>1</sup>, the system of claims 8-19 directs to software per se.

The computer program product as recited in claims 20-25 does not produce a tangible result as set forth in MPEP 2106 (IV)(B)(2)(b)(ii)<sup>2</sup>, e.g., *to cause the computer device to store* is not a tangible result because the claimed limitation just indicates the purpose of *the second computer program codes* and the information has not been stored in the process.

The computer method as recited in claims 26-30 does not produce a tangible result as set forth in MPEP 2106 (IV)(B)(2)(b)(ii), e.g., *communicating data related to the product* is not a tangible result. The result of communicating is still unknown and not being used for *populating the merchandising product database* as recited in the preamble.

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<sup>1</sup> MPEP 2106 (IV)(B)(2)(a):

Products may be either machines, manufactures, or compositions of matter.

A *machine* is "a concrete thing, consisting of parts or of certain devices and combinations of devices." *Burr v. Duryee*, 68 U.S. (1 Wall.) 531, 570 (1863).

If a claim defines a useful machine or manufacture by identifying the physical structure of the machine or manufacture in terms of its hardware or hardware and software combination, it defines a statutory product. See, e.g., *Lowry*, 32 F.3d at 1583, 32 USPQ2d at 1034-35; *Warmerdam*, 33 F.3d at 1361-62, 31 USPQ2d at 1760. Office personnel must treat each claim as a whole. The mere fact that a hardware element is recited in a claim does not necessarily limit the claim to a specific machine or manufacture. Cf. *In re Iwahashi*, 888 F.2d 1370, 1374-75, 12 USPQ2d 1908, 1911-12 (Fed. Cir. 1989), cited with approval in *Alappat*, 33 F.3d at 1544 n.24, 31 USPQ2d at 1558 n.24.

<sup>2</sup> MPEP 2106 (IV)(B)(2)(b)(ii):

For such subject matter to be statutory, the claimed process must be limited to a practical application of the abstract idea or mathematical algorithm in the technological arts. See *Alappat*, 33 F.3d at 1543, 31 USPQ2d at 1556-57 (quoting *Diamond v. Diehr*, 450 U.S. at 192, 209 USPQ at 10). See also *Alappat* 33 F.3d at 1569, 31 USPQ2d at 1578-79 (Newman, J., concurring) ("impatentability of the principle does not defeat patentability of its practical applications") (citing *O'Reilly v. Morse*, 56 U.S. (15 How.) at 114-19). A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result; i.e., the method recites a step or act of producing something that is concrete, tangible and useful. See *AT & T*, 172 F.3d at 1358, 50 USPQ2d at 1452. Likewise, a machine claim is statutory when the machine, as claimed, produces a concrete, tangible and useful result (as in *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601) and/or when a specific machine is being claimed (as in *Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557 (\**en banc*)). For example, a computer process that simply calculates a mathematical algorithm that models noise is nonstatutory. However, a claimed process for digitally filtering noise employing the mathematical algorithm is statutory.

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***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Musgrove et al. [USP 6,535,880 B1].**

Regarding claims 1 and 20, Musgrove teaches *a method of populating a merchandising product database*, comprising:

*obtaining merchandising data related to a product from a point of presentation of the product*

(*merchandising data related to a product, e.g., product descriptions, pricing..., is obtained by Web Crawlers from a point of presentation of the product, e.g., merchant server 40 (Col. 5, Lines 18-22));*  
and

*storing at least part of the obtained merchandising data in the merchandising product database (the obtained merchandising data, e.g., product descriptions, pricing..., is stored in merchandising product database, e.g., product database 26 (Col. 5, Lines 18-20)).*

Regarding claims 8 and 14, Musgrove teaches a merchandising database system, comprising:

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*an interface configured to coupled to a network and to receive merchandising data related to a product from a point of presentation of the product*<sup>3</sup> (a browser application is *an interface configured to coupled to a network for receiving merchandising data related to a product from a point of presentation of the product* (Col. 5, Lines 28-43)); and

*a database configured to store at least part of the received merchandising data*<sup>4</sup> (Col. 5, Lines 18-27).

Regarding claims 2 and 21, Musgrove teaches all of the claimed subject matter as discussed above with respect to claims 1 and 20, Musgrove further discloses the step of *obtaining the merchandising data directly from a presentation device on which the product is presented* (Col. 5, Lines 18-22).

Regarding claim 26, Musgrove teaches *a method of populating a merchandising product database, comprising:*

*rendering at least a portion of an interactive catalog, wherein content of the rendered portion includes description of one or more products and wherein the content is obtained from one or more source product databases* (Col. 5, Lines 28-43),

*communicating data related to the products to the merchandising product database such that data is communicated from the source product databases to the merchandising product database* (Col. 5, Lines 18-

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<sup>3</sup> MPEP 2111.04:

- (A) "adapted to" or "adapted for" clauses;
- (B) "wherein" clauses; and
- (C) "whereby" clauses.

The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a "whereby" clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention." *Id.* However, the court noted (quoting *Minton v. Nat 'l Ass 'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a "whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited." *Id.*

Examiner respectfully suggests applicants replacing the intended use clause, e.g., *to receive merchandising data*, by a positive statement that discloses the claimed invention.

<sup>4</sup> See footnote 2.

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27) *without requiring direct data importation* (the data is obtained via automated Web Crawlers (Col. 5, Lines 18-27)).

Regarding claims 3 and 22, Musgrove teaches all of the claimed subject matter as discussed above with respect to claims 1 and 20, Musgrove further discloses the step of *obtaining data about the product directly from the point of presentation of the product* (Col. 5, Lines 18-22).

Regarding claim 4, Musgrove teaches all of the claimed subject matter as discussed above with respect to claim 1, Musgrove further discloses *the merchandising product database does not have information related to the product stored therein prior to the storing step* (Col. 5, Lines 22-28).

Regarding claims 5 and 23, Musgrove teaches all of the claimed subject matter as discussed above with respect to claims 1 and 20, Musgrove further discloses the step of *obtaining the merchandising data generally contemporaneously with presentation of the product* (Col. 3, Lines 40-53 and Col. 5, Lines 12-27).

Regarding claims 6 and 24, Musgrove teaches all of the claimed subject matter as discussed above with respect to claims 1 and 20, Musgrove further discloses *the point of presentation comprises an output medium of an interactive catalog* (Col. 4, Lines 59-65 and Col. 5, Lines 6-10).

Regarding claims 7 and 25, Musgrove teaches all of the claimed subject matter as discussed above with respect to claims 1 and 20, Musgrove further discloses *the point of presentation comprises a Web-page* (Col. 5, Lines 6-10).

Regarding claims 9 and 15, Musgrove teaches all of the claimed subject matter as discussed above with respect to claims 8 and 14, Musgrove further discloses *the interface is configured to receive the merchandising data directly from a presentation device on which the product is presented* (Col. 5, Lines 28-46).

Regarding claims 10 and 16, Musgrove teaches all of the claimed subject matter as discussed above with respect to claims 8 and 14, Musgrove further discloses *the interface is configured to receive data about the product directly from the point of presentation of the product* (Col. 5, Lines 28-46).

Regarding claims 11 and 17, Musgrove teaches all of the claimed subject matter as discussed above with respect to claims 8 and 14, Musgrove further discloses *the interface is configured to receive the merchandising data generally contemporaneously with presentation of the product* (Col. 3, Lines 40-53 and Col. 5, Lines 12-27).

Regarding claims 12 and 18, Musgrove teaches all of the claimed subject matter as discussed above with respect to claims 8 and 14, Musgrove further discloses *the point of presentation comprises an output medium of an interactive catalog* (Col. 4, Lines 59-65 and Col. 5, Lines 6-10).

Regarding claims 13 and 19, Musgrove teaches all of the claimed subject matter as discussed above with respect to claims 8 and 14, Musgrove further discloses *the point of presentation comprises a Web-page* (Col. 5, Lines 6-10).



Regarding claim 27, Musgrove teaches all of the claimed subject matter as discussed above with respect to claim 26, Musgrove further discloses *the rendered portion of the interactive catalog acts as a conduit through which information from the source product databases is communicated to the merchandising product database* (Col. 5, Lines 12-25).

Regarding claim 28, Musgrove teaches all of the claimed subject matter as discussed above with respect to claim 26, Musgrove further discloses *the data related to the products comprises parameters embedded within the rendered portion of the interactive catalog* (Col. 5, Lines 28-46).

Regarding claim 29, Musgrove teaches all of the claimed subject matter as discussed above with respect to claim 26, Musgrove further discloses *the data related to the products comprises a product identification* (Col. 5, Lines 28-46).

Regarding claim 30, Musgrove teaches all of the claimed subject matter as discussed above with respect to claim 26, Musgrove further discloses *the data related to the products comprises a product description* (Col. 5, Lines 28-46).

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**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUNG Q. PHAM whose telephone number is 571-272-4040. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, TIM T. VO can be reached on 571-272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
HUNG Q PHAM  
Examiner  
Art Unit 2168

September 17, 2006